

REMARKS

Applicant respectfully requests reconsideration of this application, as amended.

Applicant thanks the Examiner for the courtesies extended to Applicant's representative during the Interview conducted on October 20, 2005.

Claims 1–24, 26, 27 and 32–35 were rejected under 35 U.S.C. § 102(b) as being anticipated by Strukel et al. (US 6,159,175). Claims 1–6, 11–14 and 22–32 were rejected under 35 U.S.C. § 102(b) as being anticipated by Renton (US 4,767,404). Claims 1–35 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of co-pending application nos. 10/406,572 and 10/406,571.

Applicant notes that the provisional, obviousness-type double patenting rejection cites two co-pending applications, neither of which has received a Notice of Allowance. Consequently, the provisional, obviousness-type double patenting rejection will be addressed by a timely-filed terminal disclaimer, in accordance with 37 C.F.R. § 1.321(c), if either co-pending application issues, or will issue, as a patent before the instant application and if the allowed claims of the instant application are not patentably distinct over either co-pending application. See, MPEP § 804.

Without acceding to the rejections under § 102, Claims 1, 11, 24, 33–35 have been amended to more clearly recite certain features of the claimed invention. Claims 36–38 have been added. Support for these amendments may be found, for example, within the Specification at pages 7–9 and 11–12. No new matter has been added. Thus, Claims 1–38 are pending.

Claims 1, 11 and 24 are directed to a phacoemulsification needle for removing a cataract from an eye, while Claims 33–35 are directed to a method of phaco-emulsification. Claims 1, 11, 24 and 33–35 recite, *inter alia*, a needle including "a threaded portion and a hub, disposed at a proximal end of the shaft, for fixing the needle to an ultrasonic device" and a tip having "a larger outside diameter than said shaft." Claims 1 and 33 recite, *inter alia*, a needle tip having "an essentially completely spherical surface except for the terminus," Claims 11 and 34 recite, *inter alia*, a needle tip having "a smooth, continuous curved surface except for the terminus," and Claims 24 and 35 recite, *inter alia*, a needle tip having "an overall smooth, continuous

curved shape.” Claims 1, 11, 33 and 34 also recite, *inter alia*, a needle tip having “an opening, defined by a rounded edge, disposed in a flat distal terminus perpendicular to the longitudinal axis of the shaft,” while Claims 24 and 35 also recite, *inter alia*, a needle tip having “a distal terminus and at least two openings arranged near the terminus.” Applicant respectfully submits that none of the cited references, taken either singly or in combination, teaches or suggests these features.

Strukel discloses a phacoemulsification instrument including a needle 16 and an ultrasonic energy directing structure. See, e.g., Abstract; Col. 11, lines 19–48; etc. Strukel fails to teach or suggest a needle tip having a larger outside diameter than the shaft, an opening, defined by a rounded edge, disposed in a flat distal terminus perpendicular to the longitudinal axis of the shaft, and either a completely spherical surface except for the flat distal end¹ or a smooth, continuous curved shape except for the flat distal end², as recited by Claims 1, 11, 33 and 34. Strukel also fails to teach or suggest a needle tip having a larger outside diameter than the shaft, an overall smooth, continuous curved shape and a distal terminus and at least two openings arranged near the terminus, as recited by Claims 24 and 35. Instead, Strukel teaches that needle 16 includes a conical transition section followed by a cylindrical section having either: an entirely open end (FIG. 36A), a closed, flat end having a single offset opening (FIG. 43), a closed, rounded end having a single offset opening (FIG. 11B) or a closed, wedge-shaped end having a single offset opening (FIGS. 37A, 44). Applicant respectfully submits that none of the remaining embodiments disclosed by Strukel, i.e., e.g., FIGS. 7A, 10B, 12B, 25A, 25B, 33A, 35A, 36A, etc., teaches or suggests these features. Consequently, Strukel fails to teach or suggest all of the features recited by Claims 1, 11, 24 and 33–35.

Renton discloses a surgical suction device with various suction ports for removing surgical debris. See, e.g., Abstract; Col. 10, lines 17–37; FIGS. 1, 2, 5; etc. Renton teaches that suction ports disposed on a first surface portion of a perforated end section act as a vacuum modulator when suction ports disposed on a second surface portion of the tip become clogged. See, e.g., Col. 3, lines 47–59. Renton fails to teach or suggest that suction device 10 may be used for phacoemulsification. Furthermore, Renton fails to teach or suggest a threaded portion and a hub, disposed at a proximal end of the shaft, for fixing the needle to an ultrasonic

¹ Claims 1 and 33.

² Claims 11 and 34.

device, as recited by Claims 1, 11 and 24. Instead, Renton discloses that end 32 of hollow handle 30 is attached to a vacuum source using a vacuum-type connection technique, such as a friction-type hose connection. See, e.g., Col. 7, lines 41–59; FIGS. 3 and 6. Applicant respectfully submits that such a “vacuum-type connection” is unsuitable for transmitting ultrasonic energy from an ultrasonic device. Accordingly, Renton fails to teach or suggest all of the features recited by Claims 1, 11 and 24.

Moreover, Applicant submits that none of the remaining references, taken either singly or in combination, teaches or suggests all of the features recited by Claims 1, 11, 24 and 33–35.

Accordingly, Claims 1, 11, 24 and 33–35 are allowable over the cited references. Claims 2–10, depending from Claim 1, Claims 12–23, depending from Claim 11, Claims 25–32, depending from Claim 24, and Claims 36, 37 and 38, depending from Claims 33, 34 and 35, respectively, are also allowable, at least for the reasons discussed above.

In view of the amendments and remarks presented herein, Applicant respectfully submits that this application is in condition for allowance and should now be passed to issue.

A Notice of Allowance is respectfully solicited.

If any extension of time is required in connection with the filing of this paper and has not been requested separately, such extension is hereby requested. The Commissioner is hereby authorized to charge any fees and to credit any overpayments that may be required by this paper under 37 C.F.R. §§ 1.16 and 1.17 to Deposit Account No. 02-2135.

Respectfully submitted,

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